



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Toshio SUGIURA

Group Art Unit: 2854

Application No.: 10/809,438

Examiner: J. CULLER

Filed: March 26, 2004

Docket No.: 118735

For: RECORDING MEDIUM CONVEYING DEVICE AND IMAGE FORMING APPARATUS INCLUDING THE SAME

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby requests review of the September 21, 2007 Final Rejection in the above-identified application. A Notice of Appeal and fee in the amount of \$500 is filed concurrently herewith. The Commissioner is also authorized to charge any additional fee or credit any overpayment associated with this communication to Deposit Account No. 15-0461. No amendments are being filed with this request. Claims 1-25 are pending in this application. Claims 1-9, 11-23 stand finally rejected. Claims 10 and 24 stand objected to.

Applicant appreciates the courtesies extended to Applicant's representatives by Examiner Culler in the March 8, 2007, personal interview.

BASIS OF REQUEST

Applicant respectfully submits that the basis of the prior art rejections asserted in the September 21, 2006 Final Rejection and maintained by the March 5, 2007 Advisory Action contain clear legal deficiencies. Such legal errors permit the reversal of a Final Rejection during a Pre-Appeal Brief Conference (see July 12, 2005, Official Gazette).

BACKGROUND

The September 21 Final Rejection first rejects claims 1-9, 11, 16, 18-23 and 25 under 35 U.S.C. §103(a) over U.S. Patent No. 5,580,042 to Taniguro (hereinafter "Taniguro") in view of U.S. Patent No. 6,712,357 to Tranquilla. The Final Rejection secondly rejects

claims 12 and 13 under 35 U.S.C. §103(a) over Taniguro in view of Tranquilla, and further in view of U.S. Patent No. 5,129,749 to Sato. The Final Rejection thirdly rejects claims 14 and 15 under 35 U.S.C. §103(a) over Taniguro in view of Tranquilla, and further in view of U.S. Patent No. 4,619,451 to Dodge. The Final Rejection fourthly rejects claim 17 under 35 U.S.C. §103(a) over Taniguro in view of Tranquilla, and further in view of U.S. Patent No. 4,053,224 to Burkard. The Final Rejection objects to claims 10 and 24 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Because, as argued in Applicant's February 21, 2007 Amendment, the second, third and fourth rejections are premised upon the reasoning of the first rejection. Applicant will address the legal flaws of the first rejection below. Such legal flaws equally apply to the second, third and fourth rejections as well.

As acknowledged by the Final Rejection, Taniguro at least fails to disclose a nipping force changing unit that changes a nipping force of a pair of first conveyor rollers and a controller that controls an operation of the nipping force changing unit in accordance with the position of a recording medium detected by the detector, as recited in claims 1 and 16.

Thus, in response to the first rejection Applicant argued that Tranquilla fails to make up for the deficiencies of Taniguro. In particular, Tranquilla discloses, in addition to the pinch force relief mechanism 152 and the control element 154, a capstan element 118 and its corresponding pinch roller element 120. The capstan element 118 and its corresponding pinch roller element 120, as described by Tranquilla, prevent external forces from affecting the position of a document. Furthermore, modifying Taniguro to include the pinch force relief mechanism 152 and control element 154 alone, would render the modified system inoperable and thus unsuitable for its intended purpose in violation of MPEP §2143.01(V).

Because the asserted combination of Taniguro and Tranquilla would render Taniguro unsuitable for its intended purpose, the rejection is improper. Thus, claims 1 and 16 are patentable over the combination of Taniguro and Tranquilla. Further, claims 2-9, 11, 18-23 and 25 are patentable for at least the reasons that claim 1 and 16 are patentable, as well as for the additional features they recite. Thus, Applicant respectfully requested withdrawal of the rejection.

CLEAR LEGAL ERROR

Although the Advisory Action is silent with respect to why the claim rejections are maintained, based on the March 8, 2007 personal interview, Applicant interprets the Advisory action as maintaining the reasons set forth in the Final Rejection. That is, the Advisory Action maintains the asserted combination of Taniguro and Tranquilla would have been obvious to one having ordinary skill in the art. Particularly, the Advisory Action maintains that it would be obvious to modify Taniguro to include only the pinch force relief mechanism 152 and control element 154 of Tranquilla. However, this reasoning is legally flawed.

In order to establish a *prima facie* case of obviousness, three criteria must be met (MPEP §§ 2142, 2143). 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings. 2) There must be a reasonable expectation of success. 3) The prior art reference (or references when combined) must teach or suggest all of the claim limitations. The first two criteria must both be found in the prior art, and not based on Applicant's disclosure.

In this respect, MPEP §2143.01(V) makes it clear that there can be no motivation to modify a reference if the proposed modification would render the modified reference unsatisfactory for its intended purpose.

Tranquilla clearly discloses capstan element 118 and pinch roller element 120 controls the document when the pinch relief mechanism 152 is in a non-pinch force mode (col. 4, lines 41-50). That is, in the absence of capstan element 118 and pinch roller element 120, and when the pinch relief mechanism 152 is in a non-pinch force mode, no structure would control the document, thus allowing the document to become out of alignment during processing. Examiner Culler admitted during the personal interview of March 8, that capstan element 118 acts as a stabilizer for the system.

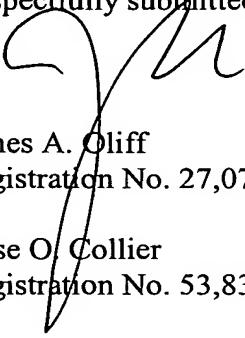
There is no structure in Taniguro corresponding to capstan element 118 and pinch roller element 120. Importantly, were the device of Taniguro modified to include 152 and 154 as suggested by the Final Rejection, a document would become out of alignment during recording, thus rendering the modified device unsuitable for its intended purpose of preventing the floating (i.e., becoming out of alignment) during recording (see col. 2, lines 3-5).

Accordingly, the reasoning relied on by the September 21, 2006 Final Rejection violates MPEP §2143.01(V) and thus contains a clear legal error.

CONCLUSION

For at least the foregoing reasons, one or more of the prior art rejections asserted in the Final Rejection have been maintained based on clear legal error. Thus, withdrawal of the Final Rejection and allowance of this application is respectfully requested.

Respectfully submitted,


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